

REMARKS

Claims 16-19, 22-25 and 27-29 are pending in the present application after cancellation of claim 20. Applicants respectfully request reconsideration of the pending claims.

Claims 16-19, 22-25 and 27-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,911,773 ("Mutsuga"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To anticipate a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim limitation is *identically disclosed* in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). "The identical invention must be shown in as complete detail as is contained in the claim." M.P.E.P. § 2131. If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). To the extent that the Examiner may be relying on the doctrine of inherent disclosure to support the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990))

Amended claim 25 recites, in relevant parts, "a reproducing device configured to reproduce the calculated first route and the at least one second route for selection by a user; a communications unit configured to receive information regarding traffic disruptions on the calculated first route and the at least one second route, the reproducing device configured to reproduce the information regarding the traffic disruptions; and an input device configured to enable the user to manipulate or change at least one of the reproduced first and second routes by enabling the user to mark user-selected road segments on the reproducing device, the manipulated or altered routes including the user-selected road segments being selectable by the user for route guidance." The amended limitations are clearly disclosed in the Substitute Specification, e.g., p. 8, l. 10-27.

In support of the rejection, the Examiner simply states that "Mutsuga discloses an input device configured to enable the user to input data to manipulate or change the routes that [are] selected for guiding the user to travel from a starting point to a destination (see figure 16-

19)." (Office Action, p. 3). However, Mutsuga clearly fails to teach or suggest the claimed limitation regarding "an input device configured to enable the user to manipulate or change at least one of the reproduced first and second routes by enabling the user to mark user-selected road segments on the reproducing device, the manipulated or altered routes including the user-selected road segments being selectable by the user for route guidance." Mutsuga merely teaches that the user may select desired route searching conditions to identify the optimal route that includes a desired facility on the way to the destination, but there is simply no suggestion in Mutsuga regarding any possibility of "enabling the user to mark user-selected road segments on the reproducing device, the manipulated or altered routes including the user-selected road segments being selectable by the user for route guidance."

For at least the foregoing reasons, Applicants respectfully submit that claim 25 and its dependent claims 16-19, 22-24 and 27-29 are not anticipated by Mutsuga.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the pending claims 16-19, 22-25 and 27-29 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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